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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/536,969	03/28/2000	James D. Logan	A-005	4915
21253	7590	05/18/2004	EXAMINER	
CHARLES G. CALL 68 HORSE POND ROAD WEST YARMOUTH, MA 02673-2516			CHANG, JUNGWON	
			ART UNIT	PAPER NUMBER
			2154	
DATE MAILED: 05/18/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

XJ

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/536,969	LOGAN ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Jungwon Chang	2154	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on amendment B, filed on 3/5/2004.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-10 and 13-20 is/are rejected.
- 7) Claim(s) 11 and 12 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

**DETAILED ACTION**

1. Claims 1-20 are presented for examination.
2. The objection to claim 11 in the prior Office action dated 11/7/2003 is withdrawn based on Applicant's Amendment filed on 3/5/2004.
3. The text of those sections of Title 35, U.S.C. 102 or 103 not included in this office action can be found in a prior action.
4. Claims 11 and 12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
5. Claims 1-10 and 13-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schulhof et al. (US 5,572,442), hereinafter Schulhof, in view of Ostrover et al. (US 6,026,446), hereinafter Ostrover.
6. As to claims 1 and 13, Schulhof discloses the invention substantially as claimed, including a method for selectively reproducing locally stored programming signals (col. 5, lines 52-67) comprising, in combination, the steps of storing a first set of separate programming segments at a client location (i.e.,

storage medium at client stores programming segments; 50, fig. 1; col. 4, lines 57-63; col. 7, lines 6-20; col. 12, lines 54-63);

employing processing means to derive identification data from each of said first set of separate programming segments (col. 4, lines 63-64; col. 5, lines 5-8);

transmitting said identification data from said client location to a remote processing location (col. 5, lines 9-12 and 52-53; col. 6, lines 31-39; col. 9, line 65 – col. 10, line 4),

at said remote processing location comparing said identification data with a database containing identification information and associated content descriptions for each of a second set of programming segments (col. 10, line 35 – col. 11, line 15);

transmitting from said remote processing location to said client location selected ones of content descriptions stored in said database which describe said program segments (col. 6, lines 40-61; col. 10, lines 40-41), and

at said client location, presenting said selected content descriptions to a user to facilitate the selective processing of said program segments (col. 12, lines 18-26).

7. Schulhof does not specifically disclose common program segments found in both said first and said second set of programming segments. However, Ostrover discloses common program segments found in both said first and said second set of programming segments (col. 14, lines 35-54; col. 20, lines 44-47). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Schulhof and Ostrover because common program segments in Ostrover's would

improve the mirroring contents of Schulhof's system by allowing users to redundantly record the common programs, thereby allowing seamless play to take place (Ostrover, col. 20, lines 44-47).

8. As to claim 2, Schulhof discloses at least some of said programming signals are recorded musical performance (col. 1, lines 8-13).

9. As to claim 3, Schulhof discloses content descriptions specify one or more attributes of the corresponding recorded musical performance from the group of attributes consisting of the title, performer, composer and date of the corresponding recorded musical performance (i.e., program guide; col. 5, lines 5-8).

10. As to claim 4, Schulhof discloses the first set of programming signals comprises receiving and recoding broadcasted programming signals (col. 5, lines 52-67).

11. As to claim 5, Schulhof discloses the identification data contained in the database are derived from the broadcasted programming signals (col. 9, line 65 – col. 10, line 14).

12. As to claim 6, Schulhof discloses specifying the beginning and end time of each of said program segments (i.e., broadcast schedule; col. 6, lines 19-23).

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13. As to claim 8, Schulhof further discloses maintaining a stored library (18, fig. 1) containing the second set of programming segments at the remote processing location (14-16, fig. 1; col. 6, lines 8-13), accepting a retrieval request from the client location (col. 5, lines 9-12 and 52-53; col. 6, lines 31-39; col. 9, line 65 – col. 10, line 4), and responding the request by transmitting to the client (col. 6, lines 40-61; col. 10, lines 40-41).

14. As to claim 9, Schulhof discloses uploading a copy of a program segment stored locally at said client location to said remote processing location (i.e., two-way communications; col. 5, lines 9-12 and 52-53; col. 6, lines 31-39; col. 9, line 65 – col. 10, line 4).

15. As to claim 10, Schulhof discloses posting an entry upon the transmittal of the identification data to the remote processing location, subsequently transmitting a playback request identifying the client location and identifying a requested program segment (col. 10, lines 52-65).

16. As to claims 14 and 18-20, Schulhof discloses displaying the program guide data for use at the client station to facilitate the selection and reproduction of desired ones of the particular programs (col. 5, lines 5-8).

17. As to claim 16, Schulhof discloses recording and processing the broadcast signal

at the client location are performed by a programmed personal computer (64, 66, fig. 2; col. 11, lines 60-64; col. 12, lines 40-46).

18. As to claim 17, Schulhof discloses the communication channel is the Internet (col. 13, lines 46-55).

19. As to claim 7, they are rejected for the same reasons set forth in claim 1.

20. As to claim 15, they are rejected for the same reasons set forth in claim 6.

21. Applicant's arguments filed on 3/5/2004 have been fully considered but they are not persuasive.

22. In the remarks, applicant argued in substance that

(1) Schulhof does not suggest that the contents of a directory channel would or should be recorded at the client location (on page 7 of remarks).

(2) Schulhof nowhere suggests that the catalog itself would be downloaded and stored at the client location (on pages 7-8 of remarks).

(3) Schulhof does not suggest that such derived identification information is ever transmitted to the remote processing location or used for any purpose other than to select recorded material for playback (on page 8 of remarks).

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- (4) Schulhof does not suggest that selections made from the menu are derived from the program segments already stored at the client location (on page 8 of remarks).
- (5) Schulhof does not suggest that selection is not "identification data" that is derived from the program segments stored at the client location.
- (6) Examiner omitted the word "common" in the quoted phrase which reads: "transmitting from said remote processing location to said client location selected ones of content descriptions stored in said database which describe said common program segments".

23. Examiner respectfully traverses applicant's remarks.

As to point (1), In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the contents of a directory channel would or should be recorded at the client location) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Furthermore, Schulhof clearly discloses storing a first set of separate programming segments at a client location (i.e., storage medium at client stores programming segments; 50, fig. 1; col. 4, lines 57-63; col. 7, lines 6-20; col. 12, lines 54-63).

As to point (2), In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which

applicant relies (i.e., the catalog itself would be downloaded and stored at the client location) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

As to point (3), Schulhof clearly discloses transmitting the identification data from the client location to a remote processing location (i.e., client (i.e., subscriber) requests the identification data (i.e., the particular program) to the remote processing location (i.e., program distribution system, 10, fig. 1); col. 10, lines 52-65; col. 7, lines 63-66).

As to points (4) and (5), Schulhof clearly discloses at client location, employing processing means to derive identification data (i.e., particular program, identity of recorded material; col. 4, line 64; col. 10, lines 52-55) from each of said first set of separate programming segments (i.e., user selects identification data already stored at client location; col. 4, lines 63-64).

As to point (6), Applicant is directed to the paragraph 7 above.

24. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jungwon Chang whose telephone number is (703)305-9669. The examiner can normally be reached on 8:30-6:00 (Monday-Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng-Ai An can be reached on (703)308-9052. The fax phone numbers for the organization where this application or proceeding is assigned are (703)746-7239 for regular communications and (703)746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-9669.

Jungwon Chang  
May 14, 2004

  
JOHN FOLLANSBEE  
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